

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Scott A. Fath et al.

Application No.: 10/659810

Confirmation No.: 5228

Filed: September 11, 2003

Art Unit: 3728

For: TEN PACK CARTON SEPARABLE INTO
MULTIPLE PACK RETAIL UNITS

Examiner: B. P. Gehman

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

Dear Sir:

Pursuant to the communication dated October 30, 2007 entitled "Notification of Non-Compliant Appeal Brief", an amended Brief is attached.

Entry of the amended Appeal Brief is respectfully requested.

Respectfully submitted,

By 

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APPEAL BRIEF

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Dear Sir:

As required under § 41.37(a), this brief is filed within two months of the Notice of Appeal filed in this case on September 13, 2005, and is in furtherance of said Notice of Appeal.

The fees required under § 41.20(b)(2) are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1206:

- I. Real Party In Interest
- II Related Appeals and Interferences
- III. Status of Claims
- IV. Status of Amendments

V.	Summary of Claimed Subject Matter
VI.	Grounds of Rejection to be Reviewed on Appeal
VII.	Argument
VIII.	Claims
IX.	Conclusion
Appendix A	Claims

I. REAL PARTY IN INTEREST

The real party in interest is Philip Morris USA Inc. by virtue of an assignment duly recorded in the Patent and Trademark Office on September 11, 2003, at Reel 014497 Frame 0142 (6 pages).

II. RELATED APPEALS, INTERFERENCES, AND JUDICIAL PROCEEDINGS

There are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 14 claims pending in application.

B. Current Status of Claims

1. Claims canceled: 0
2. Claims withdrawn from consideration but not canceled: 0
3. Claims pending: 1-14
4. Claims allowed: 0
5. Claims rejected: 14

C. Claims On Appeal

The claims on appeal are claims 1-14.

IV. STATUS OF AMENDMENTS

No response was filed to the Final Office Action dated June 13, 2005. A copy of claims 1-14 is attached as an Appendix to the Appeal Brief.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The invention herein relates to a ten pack carton blank 10 separable for retail purposes into multiple pack retail units of less than ten packs. (Specification page 1, paragraph 001; Figures 1, 4, 7, 10 and 14).

The blank 10 includes a bottom wall 12 together with upstanding front and rear walls 14, 16, respectively. A top wall 18 extends from the rear wall 16 and a top closure flap 20 extends from the front wall 14. The front wall includes end walls 22, 24 at the sides thereof while the rear wall 16 includes end closure flaps 26, 28. Bottom flaps 30, 32 extend from the sides of the bottom wall 12. (Specification page 6, paragraph 0031; Figures 1 and 4).

The carton blank 10 includes perforated score lines 40, 40A, 40B, 40C and 40D for separating an assembled ten pack carton into smaller multi-pack retail units.

(Specification, page 7, paragraph 0033; Figures 1, 4, 7, 10 and 14).

Each of the smaller retail units has at least one open end exposing the packs therein. Adhesive glue dots 38 are placed inside the carton to releasably secure the packs in place and thereby prevent the packs from falling out of each retail unit.

(Specification page 7, paragraph 0033, Figures 3, 6, 9, 12, 13 and 16).

Independent claims 1 and 13 specifically define a ten pack carton blank 10 for packaging ten packs 42 in two rows with five packs in each row in side-to-side abutting relationship with one another (Figure 2). The blank includes front 14, rear 16, top 20, bottom 12 and side wall 22, 24, 26, 28 structure totally enclosing the packs 42.

(Specification page 6, paragraph 0031; Figures 1, 2 and 4).

As further recited in claims 1 and 13, the blank 10 further includes perforated score lines 40, 40A, 40B, 40C and 40D for separating an assembled ten pack carton into smaller multi-pack retail units. (Specification page 7, paragraph 0033; Figures 1, 4, 7, 10 and 14). Each smaller retail unit has at least one open end exposing at least one of the packs 42 therein, and the packs are secured within the smaller multi-pack retail units. (Specification page 7, paragraph 0033; Figures 3, 6, 9, 12, 13 and 16). Claim 13 further specifically recites glue dots 38 inside the blank adjacent the perforated score lines on opposite sides thereof as the means for releasably securing the packs 44 within each of the smaller retail units (Figures 1, 4, 7, 10 and 14).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The issues in this appeal include the following:

1. Whether or not claims 1-14 are patentable or unpatentable under 35 USC §103(a) over Guyer US 2,888,132 in view of either one of Swift US 192,883 and Meyers US 3,276,574, and further in view of Focke et al US 4,932,534 ("Focke");
2. Whether or not claims 1-14 are patentable or unpatentable over Cobler US 5,158,178 in view of either one of Swift and Meyers, and further in view of Focke; and
3. Whether or not claims 1, 3, 7 and 9 are patentable or unpatentable over Guyer in view of Focke.

VII. GROUPING OF CLAIMS

For purposes of this appeal each of the rejected claims should be separately considered, and arguments in support of patentability are submitted below.

VIII. ARGUMENT

In support of patentability, appellant submits the following with respect to the rejection of claims 1-14.

Claim 1 and dependent claims 2-12 specifically define an assembled ten pack carton separable into smaller multi-pack retail units. It is significant that each smaller retail unit has at least one open end exposing at least one of the packs therein. Equally significant is the fact that the carton blank includes front, rear, top, bottom and side wall structure that totally surrounds and encloses the packs within the formed carton.

Before the carton is separated into smaller multi-pack retail units, the packs are fully enclosed within the carton on all sides thereof, but when separated into multi-pack retail units each such retail unit has at least one open end exposing at least one of the packs therein.

Additionally, remaining independent claim 13 and dependent claim 14 define an arrangement similar to the ten pack carton blank of claim 1, but further specifically including glue dots inside the blank adjacent the perforated score lines on opposite sides of the blank for releasably securing packs within each of the smaller retail units when the carton is separated along the score lines.

The essential features of the present invention comprise a carton blank that totally encloses the packs within the assembled carton plus the feature of separating the assembled ten pack carton into smaller multi-pack retail units where each of the units has at least one open end exposing at least are of the packs therein.

Appellant respectfully submits that the subject matter of claims 1-14 is neither shown nor suggested by the prior art taken alone or in combination with one another. Basically, the rejections formulated by the Examiner rely on two primary references, namely Guyer US 2,888,132 and Cobler US 5,158,178, each of which falls short of suggesting the subject matter specifically recited in claims 1-14. The secondary references comprising Swift US 192,883 and Meyers US 3,276,574 do not address the shortcomings of Guyer and Cobler in that these references simply disclose divisible carton structure. Remaining secondary reference Focke et al US 4,932,534 ("Focke") simply shows glue dots for each of the packs within a carton.

Guyer is clearly different in that the carton fails to totally enclose the packs therein, and also because not one of the packs within the separated smaller units is secured to the carton structure. The Examiner brushes aside these limitations concluding the “obvious elimination of parts and their function”, and improperly does so without any suggestion to that effect in the prior art. In this regard, the Examiner resorts to prohibited hindsight utilizing the present disclosure as the blueprint for such modification of the Guyer disclosure.

Cobler is also significantly different in that the smaller retail units do not include at least one open end exposing at least one of the packs therein. Instead, when the carton is ultimately separated into smaller units, each of those units totally surrounds the packs. Applicant respectfully disagrees with the Examiner’s reconstruction of Cobler with the elimination of the dividers 214, 216 as an “obvious” elimination of such parts and their function. First, absent the present disclosure, there is no teaching or suggestion for such reconstruction of Cobler. Second, this reconstruction totally destroys the integrity of the smaller retail units, and without the flaps 214, 216 the packs would easily fall out of the smaller units. Only through prohibited hindsight is the Examiner able to modify the Cobler reference in this manner. There is no suggestion in the prior art for such change.

Additionally, the rejection of claims 1, 3, 7 and 9 over the combination of Guyer, and Focke falls far short of suggesting the subject matter of these claims. For the reasons discussed above, this combination fails to disclose or suggest a carton blank that totally encloses the packs within the formed carton together with the feature of

separable smaller retail units each of which has at least one end exposing at least one of the packs therein. Focke simply discloses securing each pack to the carton structure.

IX. CONCLUSION

In view of the above argument, it is submitted that claims 1-14 are indeed patentable over the prior art, and it is respectfully requested that the rejection of these claims be reversed.

Please charge our Deposit Account No. 03-2775 for any fees associated with filing this Appeal Brief, under Order No. 4981*469 from which the undersigned is authorized to draw.

Respectfully submitted,

By 

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APPENDIX A

Claims Involved in the Appeal of Application Serial No. 10/659810

Claim 1 (previously presented): A ten pack carton blank for packaging ten packs in two rows with five packs in each row in side-to-side abutting relationship with one another, the blank including front, rear, top, bottom and side wall structure totally enclosing the packs, perforated score lines for separating an assembled ten pack carton into smaller multi-pack retail units, each smaller multi-pack retail unit having at least one open end exposing at least one of the packs therein, and means securing the packs within the smaller multi-pack retail units.

Claim 2 (original): A ten pack carton blank as in claim 1 wherein the perforated score lines are arranged for separating an assembled ten pack carton into five, two pack retail units.

Claim 3 (original): A ten pack carton blank as in claim 1 wherein the perforated score lines are arranged for separating an assembled ten pack carton into two, five pack retail units.

Claim 4 (original): A ten pack carton blank as in claim 1 wherein the perforated score lines are arranged for separating an assembled ten pack carton into three, three pack retail units and one single pack.

Claim 5 (original): A ten pack carton blank as in claim 1 wherein the perforated score lines are arranged for separating an assembled ten pack carton into two, four pack retail units and one, two pack retail unit.

Claim 6 (original): A ten pack carton blank as in claim 1 wherein the perforated score lines are arranged for separating an assembled ten pack carton into two, three pack retail units and two, two pack retail units.

Claim 7 (previously presented): A ten pack carton blank as in claim 1 wherein the means securing the packs within the smaller multi-pack retail units includes a plurality of glue dots inside the blank for releasably securing packs to be packaged in the carton.

Claim 8 (previously presented): A ten pack carton blank as in claim 2 wherein the means securing the packs within the smaller multi-pack retail units includes a plurality of glue dots inside the blank, one glue dot for each of ten packs to be packaged in the carton.

Claim 9 (previously presented): A ten pack carton blank as in claim 3 wherein the means securing the packs within the smaller multi-pack retail units includes a plurality of glue dots inside the blank, one glue dot for each of four packs to be adjacent the perforated score lines.

Claim 10 (previously presented): A ten pack carton blank as in claim 4 wherein the means securing the packs within the smaller multi-pack retail units includes a plurality of glue dots inside the blank, one glue dot for each of eight packs to be adjacent the perforated score lines.

Claim 11 (previously presented): A ten pack carton blank as in claim 5 wherein the means securing the packs within the smaller multi-pack retail units includes a plurality of glue dots inside the blank, one glue dot for each of eight packs to be adjacent the score lines.

Claim 12 (previously presented): A ten pack carton blank as in claim 6 wherein the means securing the packs within the smaller multi-pack retail units includes a plurality of glue dots inside the blank, one glue dot for each of nine packs to be adjacent the score lines.

Claim 13 (previously presented): A ten pack carton blank for packaging ten packs in two rows with five packs in each row in side-to-side abutting relationship with one another, the blank including front, rear, top, bottom and side wall structure totally enclosing the packs, perforated score lines transversely extending across an assembled ten pack carton for separating the carton into smaller multi-pack retail units, glue dots inside the blank adjacent the perforated score lines on opposite sides thereof for releasably securing packs within each of the smaller retail units when the carton is

separated, and each smaller multi-pack retail unit having at least one open end exposing at least one of the packs therein.

Claim 14 (previously presented): A ten pack carton blank as in claim 13 wherein the perforated score lines are arranged for separating an assembled ten pack carton into two, five pack retail units.

APPENDIX B

Evidence involved in the Appeal of Application Serial No. 10/659810

There is no evidence.

APPENDIX C

**Related proceedings involved in the Appeal of Application Serial No.
10/659810**

There are no related proceedings.